

Remarks

Reexamination and reconsideration of this application, as amended, is requested. Claims 1, 2 and 4 – 25 remain in the application and no new claims have been added or canceled.

Applicant believes there is no charge for this response because no new claims have been added.

Response to the 35 U.S.C. § 103(a) Rejection

The Office Action rejects claims 1, 4, 12 - 13, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Nogaoka (U.S. Patent, No. 6,791,773) in view of Quesloti et al. (U.S. Patent No. 6,806,865 B2). Applicant respectfully submits that rejection has been overcome in view of the remarks that follow.

Applicants respectfully submit that the Examiner cannot satisfy the basic requirements of a prima facie case of obviousness by using Nogaoka and Quesloti to reject the pending independent claims 1, 12 and 21 (Caravella et al U.S. Patent No. 6,041,221 being combined with respect to claim 21). For the Examiner to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the references when combined must teach or suggest all of the claimed limitations. Manual of Patent Examining Procedure, Section 2143. For the reasons articulated

below, the Applicants believe that in the present case, the Examiner has not met this burden.

Applicant begins with claim 1. Claim 1 specifically recites:

" A portable communication device comprising:

a display; and

a detachable joystick; wherein the portable communication device is adapted to receive the detachable joystick, and the detachable joystick provides a user input indicated with the display, and wherein the detachable joystick is capable of being stored within the portable communication device when not in use.

Applicant submits that Nagaoka cannot be properly combined with Quesloti et al. to teach the present invention. As with Applicant's previous response, taking for granted that the operating stick of Nagaoka is equivalent to the joy stick of the present invention (please note Applicant does not make this concession but merely accepts this for arguendo), Quesloti discloses a handheld computer which includes an integrated input device configured to provide input to the handheld computer. Further, the handheld computer may include a joystick coupler which is integrated into a joypad. The joypad coupler is configured to receive at least a portion of the stylus which is configured to act as a joystick.

As required by the independent claims of the present invention, the communication device provides: "and wherein the detachable joystick is capable of being stored within the portable communication device when not in use." Applicant agrees that Nagaoka does not disclose the capability of storing the joystick within the portable communication device when not in use, but also submits that Quesloti does

not disclose this either. The office action points to FIGS 1 and 3, item 230, column 4, lines 11 -17 which provides, "Receptacle 128 may include, but is not limited to, a threaded aperture, or any other type of mechanical connecting configuration allowing relatively simple attachment and detachment of a graspable (joystick) portion 230 therefrom." However, Applicant submits that this only provides the detachable joystick 230 being stored on stylus 200 and not stored on the device itself. Indeed, due to the size of stylus, it does not appear to be capable of being store within the PDA 200 as the length appears from the figures to be greater than that of the PDA 200 with no receptacle for stylus 200. Applicant notes that at paragraph 17 of the present invention is provided that "portable communication device 50 may also comprise a slot 95 that may be used to store detachable joystick 80 when not in use." What Queslot appears to disclose is two distinct devices (the personal digital assistant [PDA] and the stylus like item 230) wherein the tip of the stylus like item 230 is capable of being removed from stylus 200 and attached the PDA to be operable as a joystick. However, neither the tip 230 nor the item itself 200 (whether or not the tip is attached to the item 200) is capable of being stored with the PDA as required by the present invention.

Applicant further submits there would be no suggestion or teaching of combining Quesloti et al. and Nagaoka as they are from different art. Quesloti et al. is a related to a PDA without communication capability and Nagaoka is related to a mobile phone. With the advantage of hindsight, PDAs have merged with mobile phone capability, however at the time of the present invention there is no suggestion of this combination. Thus, Applicant submits it would be improper to combine these two arts for a 103(a)

rejection, even if Quesloti did disclose the capability storing the stylus (which, again, Applicant submits he does not).

For at least the reasons set forth above, Applicant submits the rejection of claims 12 and 21 based on 103(a) are improper as well. Regarding claims 2, 4 – 11, 13 – 20 and 22 – 25 , as they are dependent from claims 1, 11 and 21, for at least the reasons set forth above, Applicant submits the rejection for these claims have as well been traversed.

Conclusion

Applicant believes that the foregoing is a full and complete response to the Office Action mailed 12 July 2005, and it is submitted that claims 1, 2 and 4 - 25 are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (202) 607-4607 is respectfully solicited.

Respectfully submitted,

/James S. Finn/
James S. Finn
Reg. No. 38450

Dated: August 29, 2005

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967